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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,581	11/27/2001	Suriyan Lohavichan	IBC/001/US	7313
7590 04/07/2006			EXAMINER	
MIRICK O'CONNELL 1700 WEST PARK DRIVE WESTBOROUGH, MA 01581-3941			JABR, FADEY S	
			ART UNIT	PAPER NUMBER
			3639	

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/994,581		<b>Applicant(s)</b> LOHAVICHAN, SURIYAN	
	<b>Examiner</b> Fadey S. Jabr		<b>Art Unit</b> 3639	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 27 November 2000.

2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-15 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-15 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
       Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
       Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
       a) ☐ All    b) ☐ Some \* c) ☐ None of:  
           1. ☐ Certified copies of the priority documents have been received.  
           2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
           3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
       Paper No(s)/Mail Date \_\_\_\_\_

4) ☐ Interview Summary (PTO-413)  
       Paper No(s)/Mail Date. \_\_\_\_\_

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per Claim 13, the recitation “resolving” is vague and indefinite. It is unclear to the Office what the Applicant means by “resolving.” Appropriate correction is required in the indicated claims and any subsequent recitations.

### *Claim Rejections - 35 USC § 101*

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

As per Claims 1-15, these claims recite a series of steps and are considered for the purpose of analysis under 35 U.S.C. 101 as reciting a series of steps. The claims do not recite an pre- or post-computer activity but merely perform a series of steps of selecting, creating, grouping, storing and defining information, and is directed to non-statutory subject matter. A process is statutory if it requires physical acts to be performed outside of the computer independent of and following the steps performed by a programmed computer, where those acts involve the manipulation of tangible physical objects and result in the object having a different physical attribute or structure (*Diamond v. Diehr*, 450 U.S. at 187, 209 USPQ at 8). Further, the

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claims merely manipulate an abstract idea (selecting, creating, grouping, storing and defining information). A process which merely manipulates an abstract idea or performs a purely mathematical algorithm is non-statutory despite the fact that it might have some inherent usefulness (*Sakar*, 558 F.2d at 1335, 200 USPQ at 139).

Furthermore, in determining whether the claimed subject matter is statutory under 35 U.S.C. 101, a practical application test should be conducted to determine whether a “useful, concrete and tangible result” is accomplished. See *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed. Cir. 1999); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998).

An invention, which is eligible for patenting under 35 U.S.C. 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “use, concrete and tangible result”. The test for practical application as applied by the examiner involves the determination of the following factors”

(a) “Useful” – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.

ii. if the utility is not asserted in the written description, then it must be well established.

(b) “Tangible” – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) “Concrete” – Another consideration is whether the invention produces a “concrete” result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

The claims, as currently recited, appear to be directed to nothing more than a series of steps including selecting, creating, grouping, storing and defining information without any useful, concrete and tangible result and are therefore deemed to be non-statutory. While the information may be concrete and/or tangible, there does not appear to be any useful result.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims **1-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Brookler et al., Pub. No. US2002/007303 A1 in view of Anderson et al., U.S. Patent No. 6,970,831 B1 and Fuerst, U.S. Patent No. 6,189,029 B1.

As per **Claims 1-4 and 12-15**, Brookler et al. discloses a method comprising:

- creating and storing a plurality of questions to be sent to customer service web sites (Paras, 29-30 and 51);
- defining the parameters of a service survey, including at least the questions for the survey and the service web site destination identifying information (Paras. 29-30);
- responsive to at least one parameter of the defined survey, automatically transmitting one or more questions from the survey to one or more service web site destinations from the survey (Paras. 29-30).
- creating and storing one or more dummy user profiles (Para. 62);
- selecting at least one dummy user profile for the survey (Para. 62);
- storing user actions involved in completing a web-based form (Para. 31).

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Brookler et al. fails to explicitly disclose grouping the questions into one or more groups; storing service web site destination identifying information; storing emailed responses received from the destination service web sites; automatically extracting and storing data from the stored emailed responses; selecting a question group.

However, Brookler et al. discloses publishing the survey from a publishing database to various types of respondent computing devices (Para. 30 and also see Figure 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Brookler et al. and include storing the identity information of the survey destination, because it allows the survey system to track which users have been sent the survey.

Also, Anderson et al. teaches a selecting a plurality of questions and a plurality of categories of survey questions (Col. 3, lines 20-32). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Brookler et al. and include a plurality of questions and groups of questions as taught by Anderson et al., because it allows the surveyor to obtain more accurate results from the respondents answers to the various questions.

Further, Fuerst teaches sending the survey to the users via electronic mail with the URL of the survey and also teaches automatically storing and tabulating the results, survey name, survey group ID from the survey in order to create a composite result summary (Col. 2, lines 42-45; Col. 7, line 44-Col. 8, line 10). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Brookler et al. and include storing the survey results, and automatically accessing and presenting the results as

taught by Fuerst, because it allows for a more efficient process of analyzing and tabulating the survey results.

As per **Claim 5-6**, Brookler et al. further discloses a method wherein defining service survey parameters further includes defining the survey end time (Para. 39). Brookler et al. fails to disclose defining the survey start time. However, Brookler discloses defining an end time for the poll (Para. 39). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Brookler et al. and include a start and an end time of the survey, because it allows the surveyor to define a time limit for which the respondents must finish the survey.

As per **Claim 7-8**, Brookler et al. fails to disclose defining service survey parameters further includes the survey frequency between the start time and end time; and selecting a question group. However, Anderson et al. teaches a frequency level for the survey and allowing the surveyor to select survey categories and survey questions (Col. 3, lines 2-7 and 49-52). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Brookler et al. and include selecting a question group and a frequency level as taught by Anderson et al., because it allows the surveyor to define customized questions corresponding to the respondent and a level which will control how many customers are asked questions (Col. 3, lines 2-7 and 49-52).



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As per **Claim 9**, Brookler et al. further discloses a method comprising creating and storing one or more dummy user profiles (Para. 62).

As per **Claim 10**, Brookler et al. further discloses a method includes selecting at least one dummy user profile for the survey (Para. 62).

As per **Claim 11**, Brookler et al. further discloses a method comprising storing user actions involved in completing a web-based form (Para. 31).

### ***Conclusion***

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadey S. Jabr whose telephone number is (571) 272-1516. The examiner can normally be reached on Mon. - Fri. 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fadey S Jabr  
Examiner  
Art Unit 3639

FSJ

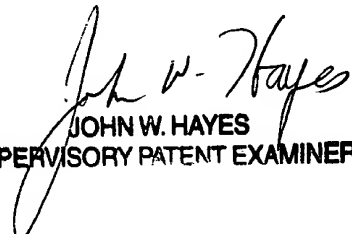
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**JOHN W. HAYES  
SUPERVISORY PATENT EXAMINER**